

REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

Claims 1-31 remain pending in this application. Claims 1-17, 24 and 29 have been amended.

Support for the amendments to claims is found throughout the application and including for example in paragraphs [0018], [0034], [0054] and others. Claim 1 has been amended to further illustrate that the coating is applied over printed indicia to highlight at least a portion of the indicia. Claim 10 has been amended to indicate that the substrate is a printed substrate. Claims 24 and 29 have been amended to highlight the surface discontinuities produced by the coating and the creation of textural properties on the substrate. All the claims recite that the substrate is used as a business communication piece, e.g. business form, presentation folder, ticket and the like as described in the present application.

Claims 1-16 have been rejected under 35 USC 112, second paragraph. Through the present amendment to the claims, applicant believes the outstanding issues have been addressed and respectfully requests reconsideration and withdraw of the present 112 rejection.

Claims 1-20 and 22-23 have been rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Young et al. (US 4,079,025). Reconsideration and withdraw of the rejection is earnestly solicited.

The standard of review under Section 102 is well known. "A claim is anticipated if each and every element as set forth in the claim is found, either expressly or inherently

described, in a single, prior art reference.” Verdegaal Bros. V. Union Oil Co., of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ...claim.” Richardson v. Suzuki Motor, Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Here there is no such anticipation.

Young et al disclose a composition that is used in creating photosensitive products, such as photographic plates and other articles. Once the coating is applied it is subjected to a “photosensitive process” (column 19, lines 3-4) or other “etching and electroplating resists” (column 19, lines 23-23). The coating is used to create shielded and unshielded areas so that the two areas can be separated from one another “by conventional means (e.g. water washing, etc.) to provide the desired pattern or image” (column 19, lines 37-40). The reference in column 19 of Young et al to various printing technologies, lithography, silk screen, offset, etc. is simply a reference to potential uses of plates that may be prepared using the shielding composition described in Young et al. Other than preparing a plate for printing, or preparing a negative, Young et al has nothing whatsoever to do with end products produced from such technology, e.g. business forms, greeting cards, etc. These items, such as business forms, greeting cards, etc. can be an end product of various printing technologies that use a printing plate.

Initially, applicant suggests that Young et al is not pertinent to the present invention in that Young et al do not disclose a printed substrate suitable for use as a business communication, e.g. a business form, greeting card, etc. Instead, Young et al discloses a coating that is used in making photosensitive plates, such as those that may be used in preparing printing plates for lithographic, offset and other printing technologies. That is, Young et al relate to a coating that is used in connection with preparing a printing plate that is used in printing equipment to produce a printed product. The invention on the other hand, relates to the product produced by a printing technology not an etched printing plate.

In lithography, offset and other printing processes a printing plate is prepared, typically by application of photosensitive chemicals which are then exposed to remove portions of the material or by etching a material such as an aluminum plate. The plates are not printed. During these processes, certain portions are removed from the material to create a “negative” (plate) which when placed on the printing press will collect ink, through use of a ink roller or fountain, and then deposit the ink onto a substrate to create a printed product. This is not the field of endeavor to which the instant invention is directed. The instant invention relates to the printed product, e.g. business form, presentation folder or greeting card, a completed product of a printing technology rather than a component used in manufacturing printed products.

Young et al also do not disclose the use of a starch based coating compound that is used to conceal odor on a printed substrate which is required by claim 1 and was present prior to the instant amendment. In addition, Young et al do not anticipate the amended claim 1 as Young et al do not disclose the use of a starch based coating that is applied over a portion of the printed or imaged indicia on the substrate. In fact, Young et al has no printing produced on the substrate to which the coating is applied, rather the pattern that is created on the substrate in Young et al is created through etching or other photosensitive processes which removes material from the surface of the substrate. As such, Young et al are not directed to a printed business communication and does not anticipate or render the present invention obvious.

Applicant believes that the disclosure in Young et al teaches away from the simplicity of its invention. The coating utilized in the instant invention is applied as a highlighting feature over the printed indicia and creates surface discontinuities to provide a textural or aesthetic feature. The starch component is added to conceal or reduce the odor of that coating and to provide surface discontinuities and not as a means by which to separate portions of the substrate one from another. Moreover, if the printed business

communication of the present invention were subjected to such “conventional means (e.g. water washing)” to finish the product as disclosed by Young et al, applicant suggests that its product would be destroyed by the washing as all that would remain would be a soggy mess and not a usable business communication product.

With respect to claim 10, Young et al do not disclose a coating including starch that is used to produce an aesthetic or textural features on a printed substrate. Claim 10 has been amended to indicate that the coating is applied to a printed substrate. Claim 10 is directed toward a printed substrate such as a business form or other business communication and not a printing plate or other photosensitive plate as disclosed by Young et al.

Likewise with respect to claim 17, Young et al do not disclose a printed substrate on which a starch containing coating has been applied to produce an aesthetic or textural characteristic on a business communication. Claim 17 does not relate to a printing plate or other photosensitive plate, but rather a business communication substrate.

Thus, Young et al do not disclose “starch compositions that can be used for intaglio printing, off-set printing and silk screen printing” (Office Action, paragraph 4) but rather discloses a starch composition that is used in preparing a printing plate that may be used in various printing presses. Young et al therefore do not anticipate the claims of the present invention as there is no disclosure concerning the production of printed products, nor does Young et al suggest a relevant teaching for the claims of the present invention.

Claims 1-5, 10-11, 13-15, 17 and 19-23 have been rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Spector (US 5,951,057). Reconsideration and withdraw of the rejection is earnestly solicited.

Spector discloses a transferable decal or tattoo on which an adhesive coating is applied and “tattoo inks forming the image are printed on the water-soluble adhesive layer” (column 4, lines 19-21). In applying the decal, “the back of the paper decal is made thoroughly wet with a damp sponge whose water is absorbed by the paper to dissolve the water-soluble adhesive layer” (column 4, lines 31-33).

The layer 20 in Spector is used to initially hold the ink to the surface of the paper and then after dissolving, allows the ink pattern to release to the surface to which the tattoo is to be applied. The adhesive layer then is destroyed to allow the tattoo to transfer to the surface to which it is to be applied. The coating used in the present invention does not provide a release or adhesive type of function instead the coating provides textural or aesthetic properties. In addition, soaking the layer as required by Spector to utilize the decal would destroy the business communication created by the present invention. Moreover, to make the disclosure of Spector relevant to the present invention, one would have to discard a portion of the disclosure, that of the ability of the ink to transfer to a surface and destroy the underlying coating. “It is impermissible to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggest to one skilled in the art” Bausch & Lomb, Inc. v. Barnes-Hind Hydorcurve, Inc., 796 F.2d 443, 448 (Fed. Cir. 1986).

Spector simply does not anticipate the claims of the present invention. The starch component in claim 1 is added to the coating to conceal odor of the coating. Spector does not disclose the use of a starch component to control odor. Spector only discloses the use of an adhesive layer which may include a starch based adhesive to hold ink to a substrate and then subsequently release the ink to a surface upon saturation with water so that the layer dissolves.

While Spector clearly does not anticipate the claims of the present invention, the claims have been amended to indicate that the starch containing coating is applied over the printing on the substrate as provided in claims 1 and 10. This is distinct from Spector which indicates that the inks are applied over the adhesive, the reverse which is now clearly recited in the claims.

In addition, the intention of the starch including coating of the present invention is to highlight certain aspects of the printing appearing on the substrate and to provide raised areas as recited in claims 10 and 17. Spector requires a smooth coating over which the ink is applied so that the ink will transfer evenly to a surface. The raised areas as required by the claims of the present invention would not permit Spector to function as disclosed since the surface irregularities would likely not allow a smooth transfer of the tattoo ink to the surface.

Spector requires that the coating is hidden by the printing and then the coating dissolves and provides no highlighting or raised areas on the substrate. Nor does Spector disclose or suggest that the coating layer provides any aesthetic or textural characteristics to the printed substrate as recited in claims 10 and 17.

Spector simply does not anticipate the claims, either before or after the amendment, of the present invention as each and every element of the claims is not found in the reference as required by section 102.

Claims 24-31 have been rejected by the Examiner under 35 U.S.C. 102(b) as being anticipated by Fujita et al (5,217,791). Reconsideration and withdraw of the rejection is earnestly solicited.

Fujita et al relate to a transparent film that is used for window displays such as “stained glass” (column 2, line 7) so that the image is visible from both sides of the window (column 2, lines 13-14). The reference deals extensively with the level of opacity of the sheet, a smooth coating to obtain the correct level of transparency and the printing that is applied to the sheet.

Fujita et al do not anticipate the claims of the present invention. The standard of review under section 102 has been discussed above. Fujita et al does not disclose the presence of the use of starch in a coating to create “surface discontinuities” on the substrate as required by claim 24. In addition, claims 24 and 29 have been amended to reflect that the coating creates textural characteristics on the substrate. Fujita et al do not disclose the presence of these elements and as such cannot anticipate the claims of the invention.

The present invention uses starches to create surface discontinuities in the coating that is applied to the substrate. Fujita et al do not provide teachings or disclosures that could be modified to include such surface discontinuities on the substrate as to do so would create differential surface gradients. Surface distortions would change the opacity of the sheet and the angle of reflection of the light passing through the sheet so that the image would not appear to be the same on both sides as required by Fujita et al. Thus, Fujita et al do not provide the disclosure or teachings to add surface discontinuities to the substrate as provided in the present invention and does not anticipate the claims.

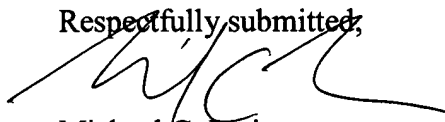
The disclosure of starches as cited by the Examiner in Fujita et al are in connection with the starches being used as an adhesive that may be used to tack the sheet to glass such as in a building, blinds or screens (column 7, lines 46-51). The invention is directed toward the preparation of business communications, articles such as business

forms, presentation folders, tickets, etc. One would not use an adhesive based starch on the surface of such substrates as to do so would cause the substrates to stick together making distribution of the substrates as business communication pieces difficult.

Fujita et al do not anticipate the claims of the present invention as the reference does not disclose or suggest each and every element recited in the claims.

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited. The Examiner is encouraged to contact the undersigned in the event any small matters remaining outstanding so as to eliminate the necessity of another action and response.

Respectfully submitted,



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